

### Office Action Summary

**Application No.**

10/590,119

**Applicant(s)**

ZHI ET AL.

**Examiner**

NIZAL S. CHANDRAKUMAR

**Art Unit**

1625

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 1/29/2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-78 and 82 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-78 and 82 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☒ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

This application is a 371 of PCT/US05/07867 03/11/2005  
which claims benefit of 60/552,690 03/12/2004.

Applicant's election without traverse of Group I, in the reply filed on 01/29/2010 is acknowledged.

compound of formula II, where  $R^1$  is CN;  $R^2$  is  $CF_3$ ; each of  $R^3$ ,  $R^4$ ,  $R^5$ ,  $R^6$ ,  $R^7$ ,  $R^{10}$ ,  $R^{12}$  and  $R^{13}$  is hydrogen; n is 0, Z is  $CR^A R^B$ , where each of  $R^A$  and  $R^B$  is hydrogen; and  $R^9$  is 1-hydroxy-2,2,2-trifluoroethyl. Claims 1-3, 5-16, 19-30, 34, 35, 62-68, 70, 78 and 82 read on the elected species.

In an interview with Attorney of record Stephanie Seidman agreement was reached so that in view of the change in the Examiner prosecuting the case, the previously presented Election/Restriction would be withdrawn and a new requirement filed.

Claims 1-78 and 82 are in the application and subject to the following  
Election/Restrictions. The withdrawn claims in the claims filed 01/29/2010 are rejoined.

### ***Election/Restrictions***

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group 1, claim(s) 1-68, 78, 82, drawn to compounds of formula II wherein n is 0, Z is CRARB.

Group 2, claim(s) 1-68, 78, 82, drawn to compounds of formula II wherein n is 1, Z is CRARB.

Group 3, claim(s) 1-68, 78, 82, drawn to compounds of formula II wherein n is 2, Z is CRARB.

Group 4, claim(s) 1-68, 78, and 82, drawn to compounds of formula (I)

Group 5, claim(s) 1-68, 78, and 82, drawn to compounds of formula (III)

Group 6, claim(s) 1-68, 78, and 82, drawn to compounds of formula (VI)

Group s 7, claim(s) 1-68, 78, 82, drawn to compounds of formula (IV) wherein n is 0, Z is CRARB.

Group s 8, claim(s) 1-68, 78, 82, drawn to compounds of formula (IV) wherein n is 1, Z is CRARB.

Group s 9, claim(s) 1-68, 78, 82, drawn to compounds of formula (IV) wherein n is 2, Z is CRARB.

Group 10 claim(s) 1-68, 78, 82, drawn to compounds of formula II wherein n is 0, Z is O.

Group 11, claim(s) 1-68, 78, 82, drawn to compounds of formula II wherein n is 1, Z is O.

Group 12, claim(s) 1-68, 78, 82, drawn to compounds of formula II wherein n is 2, Z is O.

Group s 13, claim(s) 1-68, 78, 82, drawn to compounds of formula (IV) wherein n is 0, Z is O.

Group s 14, claim(s) 1-68, 78, 82, drawn to compounds of formula (IV) wherein n is 1, Z is O.

Group s 15, claim(s) 1-68, 78, 82, drawn to compounds of formula (IV) wherein n is 2, Z is O.

Group 16 claim(s) 1-68, 78, 82, drawn to compounds of formula II wherein n is 0, Z is S

Group 17, claim(s) 1-68, 78, 82, drawn to compounds of formula II wherein n is 1, Z is S.

Group 18, claim(s) 1-68, 78, 82, drawn to compounds of formula II wherein n is 2, Z is S.

Group s 19, claim(s) 1-68, 78, 82, drawn to compounds of formula (IV) wherein n is 0, Z is S.

Group s 20, claim(s) 1-68, 78, 82, drawn to compounds of formula (IV) wherein n is 1, Z is S.

Group s 21, claim(s) 1-68, 78, 82, drawn to compounds of formula (IV) wherein n is 2, Z is S.

Group 22 claim(s) 1-68, 78, 82, drawn to compounds of formula II wherein n is 0, Z is NRD

Group 23, claim(s) 1-68, 78, 82, drawn to compounds of formula II wherein n is 1, Z is NRD.

Group 24, claim(s) 1-68, 78, 82, drawn to compounds of formula II wherein n is 2, Z is NRD.

Group s 25, claim(s) 1-68, 78, 82, drawn to compounds of formula (IV) wherein n is 0, Z is NRD.

Group s 26, claim(s) 1-68, 78, 82, drawn to compounds of formula (IV) wherein n is 1, Z is NRD.

Group s 27, claim(s) 1-68, 78, 82, drawn to compounds of formula (IV) wherein n is 2, Z is NRD.

Group 28, claim(s) 1-68, 78, 82, drawn to compounds of formula V wherein n is 0, Z is CRARB.

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Group 29, claim(s) 1-68, 78, 82, drawn to compounds of formula V wherein n is 1, Z is CRARB.

Group 30, claim(s) 1-68, 78, 82, drawn to compounds of formula V wherein n is 2, Z is CRARB.

Group 31 claim(s) 1-68, 78, 82, drawn to compounds of formula V wherein n is 0, Z is O.

Group 32, claim(s) 1-68, 78, 82, drawn to compounds of formula V wherein n is 1, Z is O.

Group 33, claim(s) 1-68, 78, 82, drawn to compounds of formula V wherein n is 2, Z is O.

Group 34 claim(s) 1-68, 78, 82, drawn to compounds of formula V wherein n is 0, Z is S.

Group 35, claim(s) 1-68, 78, 82, drawn to compounds of formula V wherein n is 1, Z is S.

Group 36, claim(s) 1-68, 78, 82, drawn to compounds of formula V wherein n is 2, Z is S.

Group 37 claim(s) 1-68, 78, 82, drawn to compounds of formula V wherein n is 0, Z is NRD

Group 38, claim(s) 1-68, 78, 82, drawn to compounds of formula V wherein n is 1, Z is NRD.

Group 39, claim(s) 1-68, 78, 82, drawn to compounds of formula V wherein n is 2, Z is NRD.

Groups 40-78, claims 69, 71-77, drawn to pharmaceutical methods of using compounds of groups 1-39 respectively. Thus, Group 78 corresponds to pharmaceutical methods of using compounds of Group 39.

The groups of inventions listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The common technical a feature found in all these groups is the arylamine structural moiety (an aryl ring substituted by a nitrogen and in para-position to it by various substituents). This invariant group, dialkylaminobenzene, is not special as it is not a contribution over prior art. Compounds with such units are well known in the prior art. For example, see Diethyl aniline is commercially available, CAS Number: 91-66-7.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention or species.

Should applicant traverse on the ground that the inventions have unity of invention (37 CFR 1.475(a)), applicant must provide reasons in support thereof.

Applicant may submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. Where such evidence or admission is provided by applicant, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product

claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NIZAL S. CHANDRAKUMAR whose telephone number is (571)272-6202. The examiner can normally be reached on 8.30 AM - 4.30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres can be reached on 571 0272-0867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Nizal S Chandrakumar/  
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